

**REMARKS**

Claims 18-26, 28-36, and 40-48 are pending. No amendments are made by this Reply.

**I. Rejections under 35 U.S.C. § 103(a)**

**A. Feder in view of Dubief**

The Office maintains the rejection under 35 U.S.C. § 103(a) of claims 18-21, 24-26, 28-32, 35, 36, and 40-48 over U.S. Patent No. 5,721,026 to Feder et al. ("Feder") in view of U.S. Patent No. 6,024,946 to Dubief et al. ("Dubief") for reasons of record and those set forth in the Office Action at pages 2-6. Office Action at page 2.

In response to Applicants' argument that there would have been no motivation to modify the composition of Feder to include the recited amount of the alpha, omega disilanol, the Office asserts that Feder and Dubief both teach similar hair care formulations, which include, among other things, an emulsion comprising an alpha, omega-disilanol. Office Action at page 3. In view of the alleged similarities of the references, the Office asserts that there is motivation for one skilled in the art to look to Dubief for a "cosmetically acceptable" amount of alpha, omega disilanol to use in the composition of Feder. *Id.* Further, the Office contends that Dubief teaches propellants as customary additives in hair care formulations, as well established in the cosmetic art. *Id.* at page 4. Applicants continue to respectfully disagree.

The Office still has not pointed to any evidence in the references demonstrating a motivation or desirability to modify the composition of Feder to include the recited amount of the at least one non-aminated silicone  $\alpha,\omega$ -disilanol. Instead, the Office

again cites to *In re Aller* for the proposition that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. Office Action at page 2. This assertion hardly supplies the “clear and particular” evidence required to provide a suggestion or motivation to modify the cited reference teachings. See *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (Evidence of a teaching, suggestion or motivation to combine reference teachings must be “clear and particular.”).

Moreover, the Office continues to take the position that although Feder et al. does not specifically recite the amount of alpha, omega-disilanol in their composition, “one of skill in the art would be motivated to look to the teachings of Dubief et al., who teach similar hair care formulations, to ascertain a cosmetically acceptable amount of alpha, omega-disilanol to add to hair care formulations.” Office Action at page 3. yet Applicants submit that “a reference must be considered for not only for what it expressly teaches, but also what it fairly suggests.” *In re Burckel*, 592 F.2d 1175, 1179, 201 U.S.P.Q. 67, 70 (C.C.P.A. 1979).

In this case, Feder discloses that its aqueous silicone dispersion compositions include an oil-water-emulsion, an aqueous dispersion of an organic (co)polymer, a cross linking agent, a nonsiliceous inorganic filler, and optionally, a metal curing catalyst. Feder at Col. 3, ll. 43-58. Although Feder generally mentions the possibility of using its aqueous silicone dispersions in cosmetic compositions, most of the disclosure in Feder is directed to non-cosmetic uses such as paint, silicone elastomer seals, water-repellant coatings for structural surfaces, coating pharmaceutical or plant-protective active substances, etc. Feder at Col. 10, line 29-Col. 11, line 19. It is in this laundry list of

applications that Feder mentions that the aqueous dispersion may also be used in "cosmetic compositions for the treatment of hair." Col. 10, ll. 9-14. Feder, however, fails to provide any guidance or preference for what in fact constitutes a cosmetically acceptable dispersion and instead, only generally discloses a combination of elements with a large number of variables. See *In re Baird*, 16 F.3d 380, 382-83, 29 U.S.P.Q.2d 1550, 1552 (Fed. Cir. 19994) (finding no suggestion in the prior art's generic formula to select a particular combination of variables that would give rise to the selection and thus, reversed rejection of obviousness).

Applicants also note that the Office supports Feder's disclosure of a cosmetic use with a citation, among others, to Example 1, Table 1. Office Action dated March 8, 2002 at page 3. In Example 1, Table 1, Feder shows the preparation of an emulsion and the testing of adhesiveness of that emulsion to glass and concrete surfaces. Feder at Col. 11, line 25-Col. 12, line 55. Nowhere in this example is it suggested to use this particular emulsion for the treatment of hair. Furthermore, the analyzed mechanical properties and the assessment of adhesion, using a 4 mm thick bead, to glass and concrete teaches away from a cosmetically acceptable composition for this particular combination.

In addition, as argued of record, Feder and Dubief disclose different compositions and there is simply no motivation for the combination stemming from the teachings themselves as is required. Accordingly, for at least these additional reasons, as well as, those of record, the Office has failed to establish a *prima facie* case of obviousness and Applicants thus respectfully request the withdrawal of the rejection.

**B. Feder in view of Dubief, further in view of Blankenburg**

The Office also maintains the rejection of claims 33-34 under 35 U.S.C. 103(a) as being unpatentable over Feder in view of Dubief, further in view of U.S. Patent No. 6,153,179 Blankenburg et al. (Blankenburg). Office Action at page 5. According to the Office, Blankenburg is relied upon to teach cosmetically acceptable propellants for use in hair care formulations, and one of skilled in the cosmetic art would be motivated to look to Blankenburg for teachings of cosmetically acceptable propellants. *Id.*

Applicants continue to respectfully disagree.

In response to Applicants' assertion that the Office fails to provide any evidence showing a reasonable expectation of success, the Office asserts that a person of ordinary skill in the art would be motivated to look to Blankenburg "since the combined references teach their compositions as comprising propellants." Office Action at page 5. The Office's broad conclusions, however, address the motivation to combine the references, not a reasonable expectation of success.

Indeed, the Office continues to ignore the requirement to show a reasonable expectation of success to establish a *prima facie* case of obviousness. See M.P.E.P. § 2143 (8th ed. Rev. 2, 2004). For reasons similar to those set forth above, there would have been no motivation to combine the teachings of Blankenburg, Dubief with Feder. Feder, Dubief, and Blankenburg are each directed to a unique combination of elements that outside each composition may not provide the same characteristics or may alter the existing composition.

For instance, Dubief's disclosure at Col. 7, ll. 48-52 merely includes "propellant" in a laundry list of optional additives. As such, Dubief fails to provide any direction or

guidance for the inclusions of such propellants let alone those disclosed in Blankenburg. This hardly amounts to "clear and particular" evidence of a suggestion or motivation to combine the particular propellants of Blankenburg or indeed that those propellants would work in the Feder/Dubief combination by the Office. *Dembiczak*, 175 F.3d at 999, 50 U.S.P.Q.2d at 1617. For this additional reason and those of record, Applicants respectfully request the withdrawal of the rejection.

**C. Feder in view of Dubief, further in view of Audousset**

Further, the Office maintains the rejection of claims 22-23 under 35 U.S.C. § 103(a) as being unpatentable over Feder in view of Dubief, and further in view of U.S. Patent No. 6,106,577 to Audousset et al. (Audousset). Office Action at page 5-6. According to the Office, there is "strong motivation" for including the specific polymer particles of Audousset in the dispersion and/or substitution for the organic copolymer of the combined references. *Id.* at page 6. Applicants continue to respectfully disagree.

The Office directs Applicants to the previous Office Action (Paper 22, Office Action dated April 7, 2003) as presenting "strong motivation" for the cited combination of references. *Id.* In the Office Action dated April 7, 2003, the Office cites the particular polymers of Audousset found in Col. 1, line 6-Col. 10, line 44. This disclosure of possible "film-forming polymers" encompasses 5 pages of double columns. Substituting the specific polymer particles identified by the Examiner in Audousset ignores the numerous other combinations in the remaining disclosure.

Moreover, Audousset does not provide any guidance or preferred teachings to choose Applicants polymer particles in claims 22-23. Thus, the Office's assertion of a

"strong motivation" is unreasonable and could be supported only if one were to use improper hindsight analysis. See *In re Fine*, 5 U.S.P.Q. 1592, 1600 (Fed. Cir. 1988) (reiterating that "[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.").

Accordingly, the rejection is improper for at least these reasons and those of record. Applicants respectfully request the withdrawal of the rejection.

### CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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